

REMARKS

The above amendment corrects the chemical structure for benzoquinones that is shown in the specification. No new matter is presented.

The sole basis for rejection presented by the examiner is for lack of an enabling specification under the first paragraph of 35 USC § 112. No issue has been raised as to compliance with the written description or best mode requirements. No issue is also presented that compounds within the scope of claim 36 cannot be made or that one skilled in this art would not be able to identify a target pest infecting a ballast water tank.

The examiner cites the factors found in *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988) (a case reversing a PTO holding that a specification was not enabling) and makes a series of findings of fact based solely on the examiner's unsupported perceptions. No citation to any reference or authoritative source was provided by the examiner. Specifically, the examiner has asserted, *inter alia*, that: (a) the art to which the present invention is directed is "unpredictable" and (b) despite a "high" level of skill in the art, that such highly skilled persons in the art would be required to engage in undue experimentation in performing a routine screening test to determine whether a specific benzoquinone compound would clean a ballast water tank of aquatic pests. (6th Action at page 3) Apparently underlying the concern for enablement is a note that claim 36 is very broad and that applicant has not presented examples that reflect testing of all pest species encompassed within the claims by all benzoquinone compounds within the claims. (6th Action at p. 4)

Wands established that the need for "some experimentation such as routine screening" did not violate the enablement requirement. 858 F.2d at 736-737.

Moreover, the test for enablement is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed. *Id.* citing *In re Jackson*, 217 USPQ 804, 807 (BOPA 1982)

The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom., Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985).

In the present case, the only experimentation that is needed is a routine exposure test of a target pest to determine whether, and at what level, a benzoquinone within the claims might be aquacidally effective. Screening tests are routinely done in the art of pesticides and toxicants of every sort: immerse the target pest

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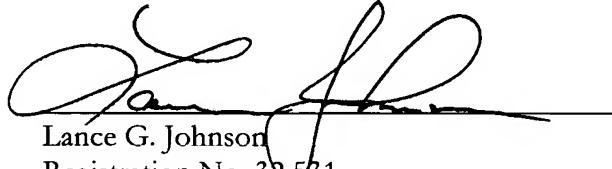
Docket No. 43257

in a solution containing a benzoquinone for several days and look to see if it has died in the interim. Mortality screening tests do not get easier than this.

There is also no requirement that an applicant test every embodiment within the scope of the claimed invention in order to provide an enabling disclosure. Indeed, no actual examples need be presented at all. MPEP § 608.01(p). In the present case, three benzoquinones (exs. 12, 14 and 15) have been presented along with other compounds to show both efficacy and screening protocol.

Applicant submit that the specification is sufficient to enable those skilled in this art to run a routine exposure and screening test to determine whether a specific compound is an aquacide and its effective concentration levels. Reconsideration and allowance are respectfully requested.

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